

105TH CONGRESS
2D SESSION

H. R. 3163

To amend the Trademark Act of 1946 to provide protection for trade dress,
and for other purposes.

IN THE HOUSE OF REPRESENTATIVES

FEBRUARY 5, 1998

Mr. COBLE introduced the following bill; which was referred to the Committee
on the Judiciary

A BILL

To amend the Trademark Act of 1946 to provide protection
for trade dress, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Trade Dress Protec-
5 tion Act”.

6 **SEC. 2. PROTECTION FOR TRADE DRESS.**

7 (a) PRINCIPAL REGISTER.—The Act entitled “An Act
8 to provide for the registration and protection of trade-
9 marks used in commerce, to carry out the provisions of
10 certain international conventions, and for other purposes.”

1 (hereinafter referred to in this Act as the “Trademark Act
2 of 1946”) is amended in section 2 thereof (15 U.S.C.
3 1052)—

4 (1) in subsection (e)—

5 (A) in clause (3) by striking “or” after
6 “them,”; and

7 (B) by inserting before the period at the
8 end the following: “, or (5) comprises any mat-
9 ter that, as a whole, is functional”;

10 (2) in subsection (f), by striking “paragraphs
11 (a), (b), (c), (d), and (e)(3)” and inserting “sub-
12 sections (a), (b), (c), (d), (e)(3), and (e)(5)”;

13 (3) by adding at the end the following:

14 “(g) Except as expressly excluded in subsections (a),
15 (b), (c), (d), and (e) of this section, trade dress which
16 functions as a mark may be registered and protected with-
17 out the need to show that it has become distinctive under
18 subsection (f) of this section if the relevant public is likely
19 to identify the source of the product or service by reference
20 to the subject matter claimed as trade dress. In determin-
21 ing whether the relevant public is likely to identify the
22 source of the product or service by reference to the subject
23 matter claimed as trade dress, the factors to be considered
24 shall include, but not be limited to—

1 “(1) whether the trade dress is unique or un-
2 usual in the particular field to which the subject
3 matter pertains;

4 “(2) whether the trade dress comprises a com-
5 mon basic shape or design;

6 “(3) whether the trade dress is a mere refine-
7 ment of commonly adopted and well known forms of
8 ornamentation for that particular class of goods or
9 services viewed by the public as a dress or ornamen-
10 tation for the goods or services; and

11 “(4) whether the trade dress is capable of cre-
12 ating a commercial impression distinct from any ac-
13 companying words.”.

14 (b) SUPPLEMENTAL REGISTER.—Section 23(c) of the
15 Trademark Act of 1946 (15 U.S.C. 1091(c)) is amended
16 to read as follows:

17 “(c) For the purposes of registration on the supple-
18 mental register, a mark may consist of any symbol, name,
19 word, slogan, phrase, surname, geographical name, nu-
20 meral, device, color, label, any matter that is not func-
21 tional, or any combination of any of the foregoing, but
22 such mark must be capable of distinguishing the appli-
23 cant’s goods or services.”.

24 (c) CONSTRUCTION AND DEFINITIONS.—Section 45
25 of the Trademark Act of 1946 (15 U.S.C. 1127) is amend-

1 ed by striking the definition of “mark” and inserting the
2 following:

3 “The term ‘trade dress’ means the total image or
4 overall appearance of a product or service, including, but
5 not limited to, the design of packaging, labels, containers,
6 displays, decor, color, the design of a product, a product
7 feature, or a combination of product features, except that
8 trade dress shall not be registered or protected under this
9 Act if it is functional.

10 “The term ‘functional’ means, with respect to matter
11 sought to be protected under this Act, that the matter is
12 of such superior design for its purpose that to afford it
13 protection under this Act would significantly hinder effec-
14 tive competition. In determining whether matter sought to
15 be protected under this Act is functional, the factors to
16 be considered shall include, but not be limited to—

17 “(1) whether the matter yields a competitive
18 advantage;

19 “(2) whether alternative designs are available;
20 and

21 “(3) whether the matter achieves economies in
22 the manufacture or use of the goods or services, or
23 affects their cost or quality.

24 “The term ‘mark’ includes any trademark, service
25 mark, collective mark, or certification mark.”.

1 (d) CIVIL ACTIONS FOR TRADE DRESS INFRINGE-
2 MENT.—Section 43(a) of the Trademark Act of 1946 (15
3 U.S.C. 1125(a)) is amended by adding at the end the fol-
4 lowing:

5 “(3) In a civil action for trade dress infringement
6 under this Act for trade dress not registered on the prin-
7 cipal register, the person who asserts trade dress protec-
8 tion has the burden of proving that the matter sought to
9 be protected is not functional.”.

10 **SEC. 3. EFFECTIVE DATE.**

11 This Act and the amendments made by this Act shall
12 take effect on the date of the enactment of this Act, but
13 shall not apply to any proceeding before the United States
14 Patent and Trademark Office relating to the registration
15 of a mark, or to any civil action, that is pending on that
16 date.

17 **SEC. 4. TECHNICAL AMENDMENTS.**

18 The Trademark Act of 1946 is amended as follows:

19 (1) Section 1(a)(1)(A) (15 U.S.C.
20 1051(a)(1)(A)) is amended by striking “goods in
21 connection” each place it appears and inserting
22 “goods on or in connection”.

23 (2) Section 7(a) (15 U.S.C. 1057(a)) is amend-
24 ed in the first sentence by striking the second period
25 at the end.

1 (3) Section 10 (15 U.S.C. 1060) is amended—

2 (A) at the end of the first sentence, by
3 striking the comma before the period; and

4 (B) in the third sentence, by striking the
5 second period at the end.

6 (4) Section 26 (15 U.S.C. 1094) is amended by
7 striking “7(c),,” and inserting “, 7(c),”.

8 (5) Section 31 (15 U.S.C. 1113) is amended—

9 (A) by striking

10 **“§ 31. Fees”;**

11 and

12 (B) by striking “(a)” and inserting “SEC.
13 31. (a)”.

14 (6) Section 32(1) (15 U.S.C. 1114(1)) is
15 amended by striking “As used in this subsection”
16 and inserting “As used in this paragraph”.

17 (7) Section 39(a) (15 U.S.C. 1121(a)) is
18 amended by striking “circuit courts” and inserting
19 “courts”.

20 (8) Section 42 (15 U.S.C. 1124) is amended by
21 striking “the any domestic” and inserting “any do-
22 mestic”.

23 (9) Section 44(d) (15 U.S.C. 1126(d)) is
24 amended—

1 (A) by striking “23, or 44(e) of this Act”
2 and inserting “23, or subsection (e) of this sec-
3 tion that is”; and

4 (B) in paragraphs (3) and (4) by striking
5 “this subsection (d)” and inserting “this sub-
6 section”.

7 (10) The Act is amended by striking
8 “trade-mark” each place it appears in the text and
9 the title and inserting “trademark”.

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